



Ailes on September 21. In the interviews, Dr. Kligler addressed the Examiner's rejection of the claims notwithstanding Applicants' Rule 131 declaration. Dr. Kligler pointed out that since the declaration proved actual reduction to practice prior to September 6, 2000, there was no need (according to MPEP 715.07(III)) to show diligence in reduction to practice of the invention during the period between September 6, 2000, and January 25, 2001.

In the follow-up interview, Examiner Ailes stated that the rejection was maintained because Applicants' declaration failed to prove actual reduction to practice of dependent claims 10-16. The Examiner gave no reason for maintaining the rejection of claims 1 and 4-9, with respect to which Applicants' declaration did prove actual reduction to practice, but said that the rejection would be reevaluated after submission of Applicants' response to the Official Action.

Claims 1, 4-13, 15, 16, 26, 29-38, 40, 41, 56, 59-68, 70 and 71 were rejected under 35 U.S.C. 103(a) over Smyk et al. (U.S. Patent 6,597,686) in view of Gaus (U.S. Patent 6,778,652) and further in view of Kurapati (U.S. Patent 6,888,937), while claims 14, 39 and 69 were rejected over these three references and further in view of Hetz (U.S.

Patent 6,185,289). Applicants respectfully traverse these rejections.

In response to the previous Official Action in this case, Applicants submitted a declaration under 37 C.F.R. 1.131 proving that the invention recited in method claims 1 and 4-9 (as well as in the corresponding apparatus and software claims 26, 29-34, 56, and 59-64) of the present patent application was reduced to practice prior to September 6, 2000. Kurapati was filed September 6, 2001, claiming the benefit of a provisional application filed September 6, 2000. Thus, on the basis of Applicants' declaration, Kurapati is not applicable as prior art against the present patent application, and the rejection under 35 U.S.C. 103(a) should have been withdrawn.

In the present Official Action, however, the Examiner maintained the rejection of all the claims on the grounds that Applicants had failed to establish diligence in reducing the invention to practice during the period between September 6, 2000, and January 25, 2001 (the filing date of Applicants' U.S. Provisional Patent Application 60/264,520).

As pointed out in the interview, this rejection is erroneous (at least with respect to claims 1, 4-9, 26, 29-34, 56, and 59-64), in view of the practice guidelines set forth in MPEP 715.07(III). This section of MPEP explains that there are three ways to show prior invention in a Rule 131

declaration, the first of which is "(A) >(actual)< reduction to practice of the invention prior to the effective date of the reference." A showing of diligence is required only "where there has not been reduction to practice prior to the date of the reference." In the present case, Applicants' declaration stated clearly that:

"Prior to September 6, 2000, we reduced our invention to practice, as described and claimed in the subject application, in Israel, a WTO country. We implemented the invention in the form of software code in the Java programming language" (paragraph 2, emphasis added).

The declaration provided ample documentary evidence that the software performed the functions of claims 1 and 4-9 and was tested and proven to work for its intended purpose before September 6, 2000. Therefore, no showing of diligence should have been required.

On this basis, Applicants again submit that claims 1, 4-9, 26, 29-34, 56, and 59-64 are patentable over the cited art.

With respect to claims 10-16 (and the corresponding apparatus and software claims 35-41 and 65-71), MPEP 715.02 states as follows:

"Even if applicant's 37 CFR 1.131 affidavit is not fully commensurate with the rejected claim, the applicant can still overcome the rejection by showing that the differences between the claimed invention and the

showing under 37 CFR 1.131 would have been obvious to one of ordinary skill in the art, in view of applicant's 37 CFR 1.131 evidence, prior to the effective date of the reference(s) or the activity."

MPEP 715.02(I) goes on to state that:

"Where a claim has been rejected under 35 U.S.C. 103 based on Reference A in view of Reference B, with the effective date of secondary Reference B being earlier than that of Reference A, the applicant can rely on the teachings of Reference B to show that the differences between what is shown in his or her 37 CFR 1.131 affidavit or declaration and the claimed invention would have been obvious to one of ordinary skill in the art prior to the date of Reference A."

Applicants took precisely the approach prescribed by MPEP 715.02 in order to establish the patentability of claims 10-16. With reference to claim 10, for example, the declaration pointed out that based on the Examiner's own analysis of the teachings of Smyk, the differences between the invention shown in the declaration and the invention of claim 10 would have been obvious to a person of ordinary skill in the art. The declaration pointed out similar facts with respect to each of claims 11-16. Therefore, based on the guidelines in MPEP 715.02, the declaration was sufficient to establish the patentability of claims 10-16 (as well as claims 35-41 and 65-71), without any further showing of diligence.

Thus, Applicants again submit that claims 10-16, 35-41 and 65-71 are patentable over the cited art. Furthermore,

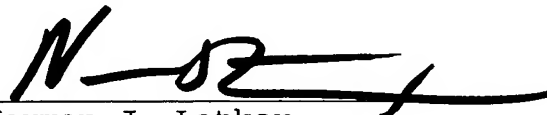
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Amdt. dated September 28, 2006
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even if it were to be assumed, for the sake of argument, that Applicants' declaration was not adequate to establish the patentability of these dependent claims, this inadequacy should have had no impact on the patentability of claims 1, 4-9, 26, 29-34, 56, and 59-64.

Applicants believe the remarks presented hereinabove to be fully responsive to all of the grounds of rejection raised by the Examiner. In view of these remarks, Applicants respectfully submit that all of the claims in the present application are in order for allowance. Notice to this effect is hereby requested.

Respectfully submitted,

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